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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,030	08/04/2003	Takemi Muroga	Komatsu Case 291	5287
23474	7590	02/16/2006	EXAMINER	
FLYNN THIEL BOUTELL & TANIS, P.C.			COOKE, COLLEEN P	
2026 RAMBLING ROAD			ART UNIT	
KALAMAZOO, MI 49008-1631			PAPER NUMBER	

1754

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,030

Applicant(s)

MUROGA ET AL.

Examiner

Colleen P. Cooke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,6,7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,6,7 and 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/24/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers were filed 10/24/05 and have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 6-7, and 10-18 are rejected under 35 U.S.C. 102(b, e, or a) as being anticipated by Honjo et al. (US 2002-0076567).

Regarding claims 4, 7, 13, 15, 16, 17, and 18, Honjo et al. teaches an oxide superconductor having a Hastelloy substrate, and IBAD-YSZ layer on the substrate, followed by a CeO<sub>2</sub> layer and lastly a Y123 layer (see Figure 1). Honjo et al. further teaches that the YSZ layer is 1 μm thick and the CeO<sub>2</sub> layer is 0.5 μm thick (Example 1, paragraph 0060; also in Example 2 paragraph 0081).

Regarding claims 6 and 16, referring particularly to the orientation of the IBAD-YSZ and CeO<sub>2</sub> layers, Honjo et al. teaches that the layers have certain alignment (paragraphs 0044, 0045, 0047, 0058, 0059, and 0069) which would appear to meet the claimed limitations. Furthermore, since Honjo et al. teaches the exact same materials formed by the same processes, the intermediate and cap layers of Honjo et al. would inherently possess the claimed orientation properties.

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With respect to each of claims 10, 11, 12, 14, and 16, it appears that the instantly claimed product by process is the same as that which is claimed (a layered superconductor consisting of a Hastelloy substrate, IBAD-YSZ layer, CeO<sub>2</sub> layer and Y123 layer). When the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct and not the examiner to show the same process as making. *In re Brown*, 173 USPQ 685 and *In re Fessman*, 180 USPQ 324.

### ***Response to Arguments***

Applicant's arguments filed 10/24/05 have been fully considered but they are not persuasive.

The applicant argues on page 9 that Honjo et al. does not disclose the formation of the second intermediate layer by pulsed laser deposition, has no disclosure with respect to the combination of an ion beam assisted deposition first intermediate layer and a pulsed laser deposition of a second intermediate layer. This argument is not persuasive because it relied upon process limitations in an attempt to distinguish product claims. It appears that the instantly claimed product by process is the same as that which is claimed (an oxide superconducting wire having a metal substrate, intermediate layer, CeO<sub>2</sub> cap layer and oxide superconducting film). When the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct and not the examiner to show the same process as making. *In re Brown*, 173 USPQ 685 and *In re Fessman*, 180 USPQ 324.

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The applicant further argues with reference to pages 12-19 of the specification and the examples detailed therein that there is a showing of “superior results” particularly with respect to critical current density, and also that they “exhibited more usefulness and practical application”. These arguments also are not persuasive for at least the following reasons.

With respect to the critical current density, it is first noted that this feature is not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., critical current density) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is also noted that the  $J_c$  values taught by Honjo et al. (Figures 4-7; Figures 5 and 7 in particular) are substantially the same as those disclosed on pages 12-19 of the specification.

Next, the applicant's arguments that the claimed invention also “exhibited more usefulness and practical application” than the prior art is further not persuasive as it is vague and unsupported. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

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Lastly, it appears that the applicant is attempting to argue that there is a showing of unexpected results. However, the rejections made over Honjo et al. are made under 35 U.S.C. 102(b, e, or a) and are anticipation rejection, not obviousness-type rejection under 35 U.S.C. 103(a) and therefore the unexpected results may not be used to overcome this rejection. This is particularly the case as there has not been a sufficient showing of any such unexpected results.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

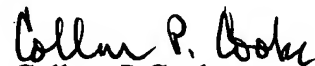
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colleen P Cooke whose telephone number is 571-272-1170. She can normally be reached Mon.-Thurs. 8am-6:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, her supervisor, Stan Silverman can be reached at 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Colleen P Cooke  
Primary Examiner  
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